

REMARKS

Claims 2, 5, 6 and 9-11 remain pending in the present application. Claim 6 has been amended to correct its dependency.

REJECTION UNDER 35 U.S.C. § 103

Claims 2, 5, 6 and 9-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over JP 6-156049 in view of JP 56-149819 and DT '451 (Figs 5 and 6) or Nagao et al. Claims 2, 5, 6 and 9-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over the prior art as applied to Claims 2, 5, 6 and 9-11 above, and further in view of Netherlands 166433. Claims 2, 5, 6 and 9-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over the prior art as applied to Claims 2, 5, 6 and 9-11 above, and further in view of Brandecker or Gebhardt or Mullin or Bates or Marstellar.

Applicant respectfully traverses this rejection by the Examiner.

The Examiner states that JP '049 appears to show and disclose all of the claimed features with the exception of an offset blower and corrugated fins. However, JP '049 does not disclose horizontally blown air or the positioning of the blower unit with respect to the passenger compartment.

The Examiner attempts to cure this lack of disclosure in JP '049 by using JP '819, which illustrates an offset blower. The Examiner justifies this combination by stating that it would be obvious to combine these references to conserve vertical space. However, there is nothing within JP '049 and/or JP '819 which provides the incentive to combine these references to conserve vertical space.

First, JP '049 discloses blowers 30 which rotate on an axis parallel to the left/right

(width) dimension of the car. Thus, if you were to separate the blowers 30 in JP '049, they would no longer blow air towards the cooling heat exchanger and would not blow air horizontally because they are designed to blow air upwardly from a position directly below the cooling heat exchanger.

The Examiner may argue that the blowers 6-8 in JP '819 replace the blowers 30 in JP '049 to conserve vertical space. Unfortunately, the two disclosures do not support this position of the Examiner. Blowers 30 in JP '049 are located entirely below this cooling heat exchanger, and so are blowers 6-8 in JP '819. Thus, it does not appear that any vertical space is saved by this combination when one looks at the distance between the cooling heat exchanger and the drain port of the two patents being combined by the Examiner. Therefore, it is clear that the Examiner is improperly combining reference under 35 U.S.C. §103. He is using hindsight reconstruction based upon Applicants' disclosure. DT 451, Netherlands 166433, Brandecker, Gebhardt, Mullin, Bates and Marstellar – either alone or in combination with the above references – do not cure the lack of motivation to combine the references.

The law is clear that there must be some suggestion or incentive to use the construction defined in Applicants' claims. For example, the Court of Appeals for the Federal Circuit in ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.d. 1572, 1577 (Fed. Cir. 1984), stated:

Obviousness cannot be established by combining the teachings in the prior art to produce the claimed invention, absent same teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.

See also, In re Gordon, 733 F. 2d 900, 902 (Fed. Cir. 1984), where the court stated:

The mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.

It is submitted that the Examiner has failed to prove that there is some suggestion or teaching in the references that would provide the practitioner with a motivation to combine their respective teachings to limit the installation space and arrive at Applicants' claimed invention.

In a decision of the Court of Appeals for the Federal Circuit, in Jones v. Hardy, 727 F. 2d 1524, 220 U.S.P.Q. 1021 (Fed. Cir. 1984), Chief Judge Markey discussed the required analysis of patentability under 35 U.S.C. Section 103. In doing so, Judge Markey noted that while a difference in a claimed invention from the prior art may serve as an element in the determination of the obviousness issue, it is improper to consider only that difference as constituting the invention. As is required and clearly set forth in Section 103, the claimed invention must be analyzed as a whole. Thus, according to Judge Markey, the test of Section 103 is not whether a difference representing an improvement would have been obvious, but whether the invention as a whole combination would have been obvious.

In a recent decision of the C.A.F.C., Panduit Corp. v. Dennison Manufacturing Co., 810 F. 2d 1561, 1 U.S.P.Q. 2d 1593 (Fed. Cir. 1987), Chief Judge Markey discussed and applied various judicial pronouncements in reversing a lower court's holding of invalidity based on obviousness under Section 103, and further cautioned against the impermissible use of hindsight in picking and choosing isolated elements from various pieces of prior art, which bear little or no relationship to each other or to the problems addressed by the Applicants' invention, in reconstructing the claimed invention

from the Applicants' own disclosure.

In the Panduit decision, Chief Judge Markey offered the opinion that such impermissible hindsight reconstruction from isolated elements in a number of prior art references in order to arrive at the claimed combination is contrary to the purpose of the patent laws.

Virtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, Section 103.

810 F. 2d at 1575, 1 U.S.P.Q. 2d at 1603. Furthermore, Judge Markey severely criticized the lower court for failing to view the claimed combination invention as a whole, but rather selecting bits and pieces from prior patents that might be modified to fit the lower court's interpretation of the claims.

Further, in the Panduit decision, Judge Markey discussed the fact that the large body of prior art, individual pieces of which show various bits and pieces of the claimed combination, can actually support a conclusion of non-obviousness, rather than serving as a basis for hindsight bit-by-bit reconstruction of the claimed invention.

Indeed, that the elements noted by the court lay about in the prior art available for years to all skilled workers, without, as the court found, suggesting anything like the claimed inventions, is itself evidence of non-obviousness. ...[The court] nowhere reconciled [its] evaluations with its contrary findings that no one skilled in the art had for years been led to those evaluations by the prior art.

810 F. 2d at 1577-78, 1 U.S.P.Q. 2d at 1605.

Judge Markey's opinion also addressed the hindsight picking and choosing problem accordingly:

The district court nowhere pointed to anything in the prior art that would have suggested the desirability, and thus the obviousness, of making the distinctive structural elements and combinations ... invented and claimed. Nor did the court succeed in the difficult task of casting its mind back into that of a person of ordinary skill in the art that had no pre-knowledge of the crucial structural differences that vitalize [the] inventions.

810 F. 2d at 1580, 1 U.S.P.Q. 2d at 1606 (emphasis in the court's opinion).

In a recent decision, the court in In re Fritch, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992), stated that:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

Id. at 1783 (emphasis in original). Here, there is no suggestion or motivation of the desirability to combine the JP'049 reference with the other references, alone or in combination. Furthermore, the court stated:

The Examiner is relying upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that:

"[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

Id. at 1784. Yet this is exactly what the Examiner has done in applying the Section 103

rejection. The Examiner has pieced together the references to allegedly render Applicants' invention obvious.

Thus, Applicants believe Claim 9 of the present invention patentably distinguishes over the art of record. Likewise, Claims 2, 5, 6, 10 and 11, which ultimately depend from Claim 9, are also believed to be patentably distinguishing over the art of record.

Reconsideration of the rejection is respectfully requested.

CONCLUSION


It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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